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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,149	04/19/2004	Yea-Yang Su	24110-RA	2717
30184	7590	06/28/2007		
MYERS & KAPLAN INTELLECTUAL PROPERTY LAW, L.L.C. CUMBERLAND CENTER II 3100 CUMBERLAND BLVD, SUITE 1400 ATLANTA, GA 30339			EXAMINER ZHENG, LOIS L	
			ART UNIT 1742	PAPER NUMBER
			MAIL DATE 06/28/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/827,149	Applicant(s) SU ET AL.	
	Examiner Lois Zheng	Art Unit 1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-19 and 43-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 13-19 and 43-72 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of invention group II, claims 13-19, in the reply filed on 6 April 2007 is acknowledged. New claims 43-72 are added in view of the claim amendments filed 6 April 2007. Claims 1-12 and 20-42 are canceled in view of applicant's amendments.
2. After further review, the examiner believes that the newly added claims are directed to more than one invention. Therefore, further restriction is required.
3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 13-19 and 43-54, drawn to a passivation solution, classified in class 106, subclass 14.05.
 - II. Claims 55-59, drawn to another passivation solution, classified in class 106, subclass 14.05.
 - III. Claims 60-63, drawn to yet another passivation solution, classified in class 106, subclass 14.05.
 - II. Claims 64-72, drawn to yet another passivation solution, classified in class 106, subclass 14.05.
4. The Group I and Group II inventions are distinct in that they are capable of separate manufacture, use, or sale as claimed and are patentable (novel and unobvious) over each other (though they may each be unpatentable because of the prior art), MPEP 802.01. In this case, the passivation solution of invention group I and

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the passivation solution of invention group II can be separately manufactured, used or
saled.

5. The Group I and Group III inventions are distinct in that they are capable of
separate manufacture, use, or sale as claimed and are patentable (novel and
unobvious) over each other (though they may each be unpatentable because of the
prior art), MPEP 802.01. In this case, the passivation solution of invention group I and
the passivation solution of invention group III can be separately manufactured, used or
saled.

6. The Group I and Group IV inventions are distinct in that they are capable of
separate manufacture, use, or sale as claimed and are patentable (novel and
unobvious) over each other (though they may each be unpatentable because of the
prior art), MPEP 802.01. In this case, the passivation solution of invention group I and
the passivation solution of invention group IV can be separately manufactured, used or
saled.

7. Because these inventions are independent or distinct for the reasons given
above and there would be a serious burden on the examiner if restriction is not required
because the inventions have acquired a separate status in the art due to their
recognized divergent subject matter, restriction for examination purposes as indicated is
proper.

8. Applicant is advised that the reply to this requirement to be complete must
include (i) an election of a species or invention to be examined even though the

requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lois Zheng whose telephone number is (571) 272-1248. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LLZ


ROY KING
SUPERVISORY PATENT EXAMINER
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